IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

On Appeal to the Board of Appeals and Interferences

Appellant(s)	:	Viveka Linde et al.	Examiner: Andrew Rudy J.
Serial No.	:	10/006,600	Group Art Unit: 3627
Filed	:	December 5, 2001	
Title	:	METHOD FOR DETERMINING THE POST-LAUNCH PERFORMANCE OF A PRODUCT ON A MARKET	

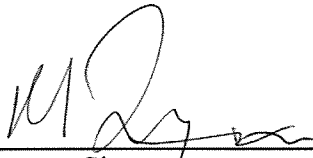| APPEAL BRIEF |
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Date of Signature

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APPEAL BRIEF

Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

On January 8, 2007, Appellants filed a Notice of Appeal from the more than twice

rejection of claims 1-3 contained in the Office Action dated on September 6, 2006. The Notice

of Appeal accompanied by a Pre-Appeal Brief Request for Review was received by the U.S.

Patent and Trademark Office on January 11, 2007. The Panel Decision on the Request for

Review indicates that there remains "at least one actual issue for appeal"

Applicants hereby timely submit, pursuant to 37 C.F.R. § 41.37, an Appeal Brief in support of the appeal of the rejection of pending claims 1-3.

I. REAL PARTY IN INTEREST

The real party in interest is IMS Health Incorporated, 660 West Germantown Pike, Plymouth Meeting, Pennsylvania 19462. ("IMS Health"). IMS Health is the owner of MEDICAL RADAR INTERNATIONAL AB LILLA BADHUSGATAN 2 GOTEBORG, SWEDEN S-411 assignee of the entire right, title, and interest in the present application by way of Assignment dated February 8, 2002 recorded on March 06, 2002 at Reel 012678 and Frame 0786

II.   <u>RELATED APPEALS AND INTERFERENCES</u>

None.

III. STATUS OF CLAIMS

Claims 1-7 were pending. Claims 4-7 were withdrawn from consideration in response to a restriction requirement imposed in an Office Action dated May 27, 2004.

In an Office Action dated September 6, 2006, claims 1-3, which are directed a method for analytical evaluation of a product marketing effort for a "specific" product in the context of the presence of several competitive products on the market were rejected under 35 U.S.C. § 103(a) allegedly as being obvious from Delurgio et al. U.S. patent No. 7,092,896 B2 ("Delurgio"), and under 35 U.S.C. § 112, second paragraph, allegedly as being indefinite.

In an earlier Office Action dated September 6, 2006, the same claims 1-3 were rejected under 35 U.S.C. § 102(a) allegedly as being anticipated by Afeyan U.S. patent No. 7,016,882 ("Afeyan").

In a yet earlier Office Action dated May 13, 2005, claims 1-3 were rejected under 35 U.S.C. 103 (a) allegedly as being obvious from Melchione et al. U.S. Patent No. 5,930,764 or its continuation-in-part — Melchione et al. U.S. Patent No. 5,966,695 ("Melchione," "Melchione CIP", or collectively "the Melchione patents").

In an even earlier Office Action dated November 26, 2004, claims 1-3 were rejected under 35 U.S.C. 102 (b) allegedly as anticipated by Shaw U.S. Patent No. 6,101,479 ("Shaw"), under 35 U.S.C. §101 allegedly as being abstract; and under 35 U.S.C. § 112 allegedly as being indefinite.

IV. STATUS OF AMENDMENTS

No requested amendments are outstanding or awaiting entry.

However, appellant notes that their Pre-Appeal Brief Request for Review requested an Examiner's Amendment to claim 1 lines 3, 5 and 7 as follows: "data ~~related to~~ on", if the Review Panel found such Amendment useful. The Panel Decision does not indicate that such Amendment was found useful.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

The invention described in the above-identified application relates to a process for an analytical evaluation of a product marketing effort for a "specific" product in the context of the presence of several competitive products on the market. The subject product may, for example, be a new pharmaceutical drug. Applicants' invention, according to claim 1, includes the steps of assembling databases of various market data specific to products including (1) data related to a success factor in a market performance of the subject product (e.g., success factors such as product detailing, adoption and capture rates); (2) data on unmet or latent product needs in the market; and (3) data on the proclivity of decision makers (e.g., prescribing physicians, insurance and hospital personnel) to choose the subject product over other products. Claim 1 further includes (4) the step of using a computer simulation model to project a future market share of the specific subject product based on the market product data assembled in steps (1) (2) and (3).

Claim 1 reads:

A method for determining the post-launch performance of a product on a market [*See Specification page 1 lines 10-11, page 2 lines 16-19*], comprising:

storing, in a database, [*See Specification page 13 lines 20-23, and Fig. 2 database 7*], collected first data related to at least one key success factor [*See Specification page 7 line 36- page 8 line 4, page 9 lines 15-25*], associated with at least a market performance which is related to said product *[See Specification page 8 lines 33- page 9 line 6]*;

storing, in a database, collected second data related to unmet product needs on said market [*See Specification page 8 lines 4-10*],;

storing, in a database, collected third data related to a propensity of a decision-maker to choose said product [*See Specification page 8 lines 10-14*];

linking a computer to said databases [*See Specification page 13 lines 20-23, FIG. 2*]; and

using a simulation model on said computer to calculate a future market share of said product based on said collected first, second, and third data, thereby determining said post-launch performance on said market [*See Specification page 5 lines 32-35, page 8 lines 24-32, page 21 lines 26- page 22 line 5, page 25 lines 14- 25, FIGS. 1 and 6, etc.*];.

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejection of claims 1-3 under 35 U.S.C. § 103(a) allegedly as being obvious from as being obvious from Delurgio et al. U.S. patent No. 7,092,896 B2 ("Delurgio"), and under 35 U.S.C. § 112, second paragraph, allegedly as being indefinite.

VII. ARGUMENT

The Examiner's has improperly rejected claims 1-3 under 35 U.S.C. § 103(a) as being obvious from Delurgio et al. U.S. patent No. 7,092,896 B2 ("Delurgio"), and under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner's rejections are incorrect and should be reversed.

35 U.S.C. § 112, second paragraph, rejection

Appellants note that their Pre-Appeal Brief requested an Examiner's Amendment to claim 1 lines 3, 5 and 7 as follows: "data ~~related to~~ on", if the Review Panel found such Amendment useful, at least in reducing the number of issues for Appeal. The Panel apparently did not find the proposed amendment useful.

Appellants submit that phrase "related to" is clear and definite as recited in claims 1-3. The phrase is readily understood in common and scientific usage to mean "associated with," "corresponding to," or "function of" (which meanings and usage, appellants respectfully note, are prevalent in the cited art (e.g., Delurgio), and remain unchanged through four previous Office Actions in which the phrase was not found indefinite). Accordingly, claims 1-3 are clear and definite and conform to all requirements of 35 U.S.C. § 112, second paragraph.

Accordingly, the § 112 indefiniteness rejection of these claims 1-3 should be reversed.

35 U.S.C. § 103(a) obviousness rejection

Appellants' invention, according to claim 1, relates to a process for an analytical evaluation of a product marketing effort for a "specific" product in the context of the presence of several competitive products on the market. The subject product may, for example, be a new pharmaceutical drug. In particular, claim 1 includes the steps of assembling databases of various

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market data specific to products including (1) data related to a success factor in a market performance of the subject product (e.g., success factors such as product detailing, adoption and capture rates); (2) data on unmet or latent product needs in the market; and (3) data on the proclivity of decision makers (e.g., prescribing physicians, insurance and hospital personnel) to choose the subject product over other products. Claim 1 further includes (4) the step of using a computer simulation model to project a future market share of the specific subject product based on the market product data assembled in steps (1) (2) and (3).

The Examiner has improperly rejected claims 1-3 under 35 U.S.C. § 103(a) by failing to make out a prima facie case of obviousness. (See Office Action, § 4 pages 2-3).

To establish a prima facie case of obviousness under §103(a), according to MPEP § 2143, three basic criteria must be met: (a) some suggestion or motivation to modify Delurgio; (b) a reasonable expectation of success; and (c) a teaching or suggestion of all the elements of claims 1-3.

According to MPEP § 2124 "[t]he initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. 'To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)."

The §103(a) rejection of claims 1-3 in the Office Action does not address or satisfy any of the three criteria required to establish a prima facie case of obviousness.

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Careful reading indicates Delurgio does not have any disclosure (explicit or inherent), which shows, teaches, suggests, or provide motivation leading to applicants' inventive quantification of the post launch market share of a specific product that is the subject of a marketing effort.

Unlike appellants' claimed process, Delurgio is not concerned with specific product marketing (e.g., by a product supplier or manufacturer), or with any numerical calculation or projection of a market share of a subject product. Instead, Delurgio relates to overall store promotion strategies for products within a product category by a store category manager. (See e.g., Delurgio col. 2 lines 34- col. 3 line 46). Delurgio describes optimizing promotion plans over a group of products to maximize net store profit taking into account demand chain costs associated with each of the products in the group (See e.g., Delurgio col. 3 line 50- col. 4 line 11, FIG. 1, etc.). Delurgio describes balancing a choice of promotional events 101, a choice of supplier offers 102, and promotion constraints 103 to output an optimized promotion plan 104 to maximize profit for a store selling a category of products. (See e.g., Delurgio col. 5 line 35- col. 6 line 34, etc.).

Delurgio does not show, teach or suggest the elements of claims 1-3. For example, with respect to claim 1, there is no teaching or suggestion in Delurgio of the steps of assembling "data on unmet or latent product needs in the market"; and "data on the proclivity of decision makers (e.g., prescribing physicians, insurance and hospital personnel) to choose the subject product over other products." Further, Delurgio does not teach or suggest the step of using a computer simulation model to project a future market share of the specific subject product. For at least this reason, the Office Action fails to make a prima facie case of obviousness.

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Appellants respectfully submit that the Office Action (See Office Action end of § 4, page 4) mistakenly generalizes all product marketing data to be the same, and mistakenly asserts that Delurgio's databases 101 102, and 103 correspond to or include (2) data on unmet or latent product needs in the market; and (3) data on the proclivity of decision makers, as required by claim 1. (See Office Action page 4).

Appellants also submit that there is no suggestion in Delurgio (or otherwise in the art) directing a person of skill in the art to modify Delurgio's disclosure (which is directed to store managers for maximizing net store profit) to arrive at applicants' invention for projecting a future market share of the specific subject product. Appellants respectfully note that the Office Action improperly uses hindsight based on Appellants' disclosure to ascribe the claimed steps to Delurgio.

For at least the reasons set forth above, claim 1-3 are non-obvious and patentable over Delurgio. Accordingly, the obviousness rejection of these claims should be reversed.

VIII.   <u>CLAIMS APPENDIX</u>

The rejections of the following claims 1-3 is appealed. The following claims 4-7 have been withdrawn, but are listed for completeness.

1.   A method for determining the post-launch performance of a product on a market, comprising:

storing, in a database, collected first data related to at least one key success factor associated with at least a market performance which is related to said product;

storing, in a database, collected second data related to unmet product needs on said market;

storing, in a database, collected third data related to a propensity of a decision-maker to choose said product;

linking a computer to said databases; and

using a simulation model on said computer to calculate a future market share of said product based on said collected first, second, and third data, thereby determining said post-launch performance on said market.

2.   A method according to claim 1, wherein said calculating comprises multiplying a numerical value representing the collected data related to said unmet needs with a numerical value representing the collected data related to said propensity and with a numerical value representing the an existing market share of at least one further, competing, product.

3.   A method according to claim 1 or 2, wherein said collected data and a results of said calculating is made available for transmission to at least one user via a network such as an internet.

4.   (Withdrawn) A computer system for determining the post-launch performance of a product on a market, comprising a database for storing collected data related to at least one key success factor associated with at least the market performance which is related to said product, for storing collected data related to unmet needs on said market and for storing collected data related to the propensity of a decision-maker to choose said product, and a central computer unit adapted for calculating the future market share of said product based on said collected data, thereby determining said post-launch performance on said market.

5.   (Withdrawn) A system according to claim 4, wherein said central computer unit and said database are connected to a network such as the Internet, the information in said database and the results of said calculating being accessible to said external user.

6.   (Withdrawn) A system according to claim 5, wherein said central computer unit is arranged so that said external user may enter information related to at least one key success factor associated with at least the market performance which is related to said product, or the unmet needs on said market or the propensity of a decision-maker to choose said product for simulating calculations by said central computer unit related to the future market performance of said product based on the information entered by said user.

7.	(Withdrawn) Computer-readable data carrier for storing market information regarding at least one first product, said information being related to at least one key success factor associated with at least the market performance of said product, said information also being related to unmet needs on said market, to the propensity of a decision-maker to choose said product, and also being related to the future market share of said product as calculated by means of said information, thereby determining said post-launch performance of said product on a market.
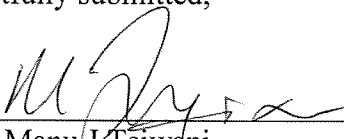
IX.   EVIDENCE APPENDIX

None.

X,   **RELATED PROCEEDINGS APPENDIX**

None.

For the foregoing reasons, the Examiner' rejection of claims 1-3 should be reversed.

Dated: _May 14, 2007_

Respectfully submitted,

By: _____
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